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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/889,349

SEP 20 2007

Filing Date: July 17, 2001

Technology Center 2100

Appellant(s): BAGLEY ET AL.

Raymond Y. Mah
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/16/2007 appealing from the Office action mailed

3/15/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,987,480	DONOHUE	11-1999
6,453,339	SCHULTZ	09-2002
6,651,108	POPP	11-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1 – 16, 23 – 30, 35 – 38, 47 - 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (U.S. 5,987,480) in view of Schultz et al (U.S. 6,453,339 B1).

◆ As per claims 1, 5, 23, 27,

Donohue et al (U.S. 5,987,480) discloses a method/apparatus of managing information bearing content files stored in a computer file system, comprising:

- “The computer file system being divided into directories” col. 13 lines 22 – 26 of Donohue.
- “Means” (Fig. 1, element 2 of Donohue) for “Locating one or more content files” corresponds to the command to locate documents (col. 7 lines 27 – 30 of Donohue).
- The “content files” corresponds to the “documents” that stored in the data source 12 in Fig. 1 (col. 7 lines 35 – 44).
- “Means” (Fig. 1, element 24 of Donohue) “Associating one or more template files with each directory in which at least one content file is stored” See col. 5 lines 25 – 31 of Donohue. The documents stored in the web server contain different formats; therefore, when applying to the template, it will carry out a respective predetermined operation on the documents (col. 1 lines 57 – 65 of Donohue).
- “Means” (Fig. 1, element 14 of Donohue) for “Applying the or each template file associated with a given directory to each content file stored in that given directory” col. 7 lines 15 – 22 of Donohue.

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- “Wherein the respective directory in which each content file is stored determines which of the or each template file is applied” col. 5, lines 63 – 67, col. 10, lines 43 – 48 of Donohue.

Donohue teaches that the data source and the templates, which organized in a directory, are stored on the server computer, but does not clearly teach that the directory stores the content file and the template. In col. 4, lines 59 – 62, Donohue teach that the data source provided the content stored in the database represents or is reduced to name/value pairs.

In addition, Schultz discloses a search system for channelized data (see the title of Schultz) that the content directory and the template directory are stored in the same place (col. 13, lines 54 – 56 of Schultz). Schultz teaches that the content file being stored in a directory of the computer file system (col. 13, lines 54 – 56 of Schultz). Schultz also teaches that “wherein the applying the one or more each template file associated with a given directory ... generates a corresponding templated information-bearing content file whose appearance is controlled by the or each associated template file” (col. 13, lines 55 – 59, Schultz teaches “there is a template directory within content directory 24”) by applying the image file in the directory with the corresponding template in that directory.

Both inventions are in the same filed (search and delivery document to user). Donohue and Schultz suggest that the invention may be modified to archive the scope of the claims (col. 14, lines 28 – 36, Donohue; col. 18, lines 26 - 30 – 47, Schultz).

The directory in Donohue includes the template and the name-value pair that represent the corresponding document. It would have been obvious to one with ordinary skill in the art at the time the invention was made to substitute the name-value in Donohue invention by the

content file of Schultz because the combination would reduce the network traffic in searching for data.

◆ As per claims 13 – 16,

With all limitation as in claim 1 further claims 13 – 16 including the steps of searching for documents in a directory and determining if whether the template is existed in that directory.

Schultz discloses a content directory associated with the templated directory (Fig. 5 of Schultz) in combination with the teaching of Donohue, the combined system would be able to searching for document in a directory (Schultz reference) and determining if whether the template is existed in that directory (either Schultz or Donohue reference).

◆ As per claims 2, 6, 24, 28, the combination of Donohue and Schultz disclose:

- “The computer file system is divided into a hierarchical arrangement of directories” col. 5 lines 26 – 30, Donohue.

◆ As per claims 3, 7, 25, 29, the combination of Donohue and Schultz disclose:

Donohue teaches that the templates are stored in the directory. Each associate with a particular document or group of documents (col. 5 lines 26 – 30, Donohue.); therefore, the association of a template with a directory is made on the basis of the template file being stored in that directory.

◆ As per claims 4, 8, 26, 30, the combination of Donohue and Schultz disclose:

- “Associating metadata with each content file” See col. 15, lines 10 – 11 of Schultz.
- “Carrying out the respective pre-determined operation on each content file... metadata” col. 1 lines 57 – 65, Donohue.

◆ As per claims 9 - 10, the combination of Donohue and Schultz disclose:

- “Computer readable code” corresponds to the “script” 14 in Fig. 1 of Donohue.
- “A signal embodying computer executable code for loading into a computer” See Fig. 1 of Donohue, col. 7, lines 1 – 44.

◆ As per claims 11 – 12, the combination of Donohue and Schultz disclose:

- “The association of a template with a directory is made on the basis of the template file being stored in at least one of that directory and a parent directory of that directory” col. 10, lines 43 – 48, Donohue.

◆ As per claims 35 - 38, the combination of Donohue and Schultz disclose:

The combination of Donohue and Schultz disclose a directory that stored both content file and the associated templates as discussed above. Therefore, the Donohue and Schultz discloses, “searching a parent directory … template files” by searching for a default template file in the parent directory (See col. 13, lines 11 – col. 14, lines 17 of Donohue).

◆ As per claims 47 - 50, the combination of Donohue and Schultz disclose:

The combination of Donohue and Schultz disclose a directory that stored both content file and the associated templates as discussed above. Furthermore, Donohue discloses a result page (information bearing content) (See Fig. 2 of Donohue). This page is generated and must be stored in the system before displayed to the user. Therefore, the directory that stored both template and the content file must be able to store the result page as claim in the invention.

◆ As per claims 51 - 54, the combination of Donohue and Schultz disclose:

- “The look up table” See col. 12, lines 59 – 62 of Schultz.

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2. Claims 31 – 34, 39 - 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (U.S. 5,987,480) in view of Schultz et al (U.S. 6,453,339 B1) as applied to claims 1 – 16, 23 – 30, 35 – 38, 47 - 54 above, and further in view of Popp et al (U.S. 6,651,108B2).

◆ As per claims 31 - 34,

The combination of Donohue and Schultz disclose a method for searching a document and using the associated templated to carried out the document. Donohue teaches that the templates may be inherited from parent directories to one or more child directories (col. 14, lines 14 – 15 of Donohue) by searching one level up the directory for the default template if the current directory does not have the default template. Donohue does not teach that one document can be applied to multiple templates so that at least one document is processed in accordance with multiple template files as claimed in claims 31 – 34 of the instant application. However, one skill in the art would recognize that depend on the type and the attributes of document, an appropriate template can be used. As Donohue teaches the relationship between the parent and child directories, a parent template can be used to the child document in the child directory.

Donohue and Schultz do not clearly disclose that one document can be applied to multiple templates so that at least one document is processed in accordance with multiple template files as claimed in claims 31 – 34 of the instant application.

However, Popp, on the other hand, discloses a method and apparatus for generating a web page (see the title of Popp) using multiple templates. Popp teaches that “multiple HTML templates can be used to generate a single HTML document” (Col. 3, lines 22 – 25 of Popp).

Since Popp and Donohue and Schultz are in the same field of endeavor, it would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the

teaching of Popp into the combination of Donohue and Schultz because the combination would provide the user different displays by using multiple templates.

- ◆ As per claims 39 - 42, the combination of Donohue, Schultz and Popp disclose:

These claims are rejected based on the rejections of claims 31 – 38 as discussed above.

- ◆ As per claims 43 - 46, the combination of Donohue, Schultz and Popp disclose:

According to col. 13, lines 10 – 21, Donohue teaches that depending on user interest product, a new template can be created. Therefore, if a new template is created based on the user need, this template will override the other template file.

(10) Response to Argument

The Federal Circuit has embraced a theory of *prima facie* obviousness for use in *ex parte* prosecution in the PTO. The *prima facie* case is a procedural tool that, as used in patent examination, means not only that the evidence of the prior art would reasonably allow the conclusion that the examiner seeks, but also that the prior art compels such a conclusion if the Appellant produces no evidence or argument to rebut it. See *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). In the instant case, the prior art compels the conclusion that the claimed invention is unpatentable under 35 U.S.C. §103(a) as set forth in the Final Office Action, mailed June 11, 2003, and reiterated above for convenience.

Argument 1: Appellant argues that Donohue patent does not disclose, “locating one or more content files, **each content file being stored in a directory** of the computer file system”. The Examiner respectfully disagrees.

Appellant’s first argument is unpersuasive because it attempts to show nonobviousness by attacking Donohue alone and nonobviousness cannot be established by attacking references

individually. Where the rejection is based upon the teaching of a combination of references, as it is here, each reference must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. See *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As set forth in the March 15, 2007 Final Office Action, the rejection of claims 1 – 16, 23 – 30, 35 – 38, 47 - 54 was made under 35 U.S.C. §103(a) as being unpatentable over the combination of Donohue *et al.* and Schultz; not Donohue *et al.* alone.

Appellant fails to recognize the combination of the two systems that the Examiner provided. Specifically, the Examiner does not use the Donohue reference to teach the “**each content file being stored in a directory**”. Instead, the Examiner provides the teaching of Schultz for the “**each content file being stored in a directory**,” which was then applied to the system of Donohue.

Schultz teaches: “ In addition, there is a template directory within content directory 24” (col. 13, lines 54 – 55). Clearly Schultz teaches that the content directory can be at the same place as the template directory. Donohue teaches “a document template corresponding to the desired document” (see the abstract of Donohue); and “when a URL is received specifying a path and file name (such as http://www.host.com/oasis/computer/monitors/xyzco/prices.htm), the immediate directory of the requested document (in this example directory xyzco) is searched for a default template default. tem” (col. 13, lines 22 – 26 of Donohue). Clearly, Donohue discloses a document directory but does not clearly teach that the template directory is in the same place as document template. However, for more convenience, one skill in the art would store the document template together with the content template for faster retrieval and reduce the network traffic.

Argument 2: Appellant argues that Donohue patent does not disclose, “Associating one or more template files with each directory in which at least one content file is stored, each template being effective, when applied to the content file, to carry out a respective pre-determined operation on the content file”. The Examiner respectfully disagrees.

Appellant stated that “Since Donohue does not disclose the initial step of locating one or more content files in a directory of the computer file system, then, there can be no associating one or more template files with a directory in which at least one content file is stored”.

However, in this case, the Appellant fails to recognize the combination of the two systems that the Examiner provided. Specifically, the Examiner does not use the Donohue reference to teach the “**each content file being stored in a directory**”. Instead, the Examiner provides the teaching of Schultz for the “**each content file being stored in a directory**,” which was then applied to the system of Donohue. Therefore, the combination between the Donohue and the Schultz patent does disclose the one or more content files in a directory, and also disclose the step of “Associating one or more template files with each directory in which at least one content file is stored, each template being effective, when applied to the content file, to carry out a respective pre-determined operation on the content file” (See the abstract of Donohue).

Argument 3: Appellant argues that Donohue patent does not disclose, “Since no content file is stored in a directory structure there can be no “applying” in the manner claimed”. The Examiner respectfully disagrees.

As discussed in argument 1, the combination between the Donohue and Schultz does discloses the content file is stored in a directory structure, when apply to the corresponding template, populates the document and delivery to the user (see abstract of Donohue).

Argument 4: Appellant argues that, “The main point of Donohue’s system is to provide customized web pages based on who is requesting the web page”. The Examiner respectfully disagrees.

As discussed in argument 1, Donohue teaches “a document template corresponding to the desired document” (see the abstract of Donohue); and “when a URL is received specifying a path and file name (such as <http://www.host.com/oasis/computer/monitors/xyzco/prices.htm>), the immediate directory of the requested document (in this example directory xyzco) is searched for a default template default. tem” (col. 13, lines 22 – 26 of Donohue). Clearly, Donohue not only provides a security system, but also provides for other user with a desired document.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Nguyen, Cam Linh



Conferees:

Apu Mofiz

SPE- 2161



John Cottingham

SPE 2167